REMARKS

The amendments to the claims find support in the specification and claims as originally filed. For example, the amendment to claim 1 find support in claim 1 as originally filed, and at, for example, pages 3-6 of the specification, page 14, lines 10-15. No new matter is added by way of the amendments. With these amendments, claims 1-3, 9-11, 15, 17, and 21-22 are pending in the application.

In the Office Action, the Examiner vacated the previous restriction requirement and subjected the claims to a new restriction requirement.

Applicants hereby provisionally elect Group I with traverse.

Applicants were further "required to elect a single Sequence identified by a specific sequence identification number."

Applicants hereby provisionally select, with traverse, a compound of SEQ ID NO: 1, in which X1 is SEQ ID NO:3, X2 is L, and X3 is SEQ ID NO:22 as the single Sequence .

Applicants respectfully traverse the restriction requirement and the requirement to elect a single Sequence for at least the reasons discussed below.

The Examiner asserts in the Office Action that the claims disclose a plurality of distinct inventions, drawn to products having different chemical structures, functions, and different effects. Applicants respectfully submit that all the inventions disclosed in the instant application are related inventions that share a **common chemical structure**, being directed either to polypeptides having common features and stretches of common amino acid sequences, or to nucleic acids encoding such polypeptides, and methods of using such polypeptides and nucleic acids encoding them. Moreover, all the inventions disclosed in the instant application are related inventions that share a **common function** in that all the polypeptides of the invention are directed to the function of affecting the interaction between a p50/dynamitin protein and the native kinetochore protein ZW10. In addition, all the inventions disclosed in the instant application are related inventions that produce the **common effect** of modulating, and preferably inhibiting, cellular proliferation.

Thus, for at least the reasons that the polypeptides, nucleic acids, recombinant cells, compositions, methods for using and methods for identifying are all directed to polypeptides that have related structure, serve the same function, have related modes of operation, and have related utility, applicants respectfully submit that examination of claims 1-27 as submitted would not place a serious burden on the Examiner, and would facilitate the expeditious examination of the claimed invention.

Searching the Claims Would Not Pose a Serious Burden on the Examiner

Applicants respectfully submit that different searches are not required in order to search the inventions of claims 1-27. All claims are directed to compounds, compositions, cells and methods directed at modulating or inhibiting cellular proliferation. The mode of action of the compounds, compositions and methods are all related to the polypeptides of the invention, and are related by being directed to affecting the interaction between p50/dynamitin and the kinetochore protein ZW10. Applicants respectfully submit that the polypeptides of the invention do not comprise divergent subject matter that have acquired a separate status in the art.

Applicants respectfully submit that multiple searches are unnecessary to identify references of relevance to all pending claims. A single search sufficing, no serious burden would be placed on the Examiner. Thus, for at least the reasons that the polynucleotides of the invention are related by structure, function, and utility, applicants respectfully submit that claims 1-27 disclose related inventions that may be searched together without serious burden on the Examiner.

Any Perceived Burden on the Examiner Can Be Reasonably Minimized by an Election of Species Requirement

Claims 1-27 include generic claims that recite polypeptides and polynucleotides encoding these polypeptides that share common elements, functions and uses (e.g., inhibition of cellular proliferation). The generic claims are suitably limited in scope, and define those cellular proliferation inhibitors that find use with the invention.

Applicants believe that additional restriction to recite a single sequence is inappropriate, and such proposed restriction would appear to be more consistent with election of species practice. If this restriction requirement were reassessed and made an election of species

requirement, the Applicants would elect a single sequence, and that sequence would be examined only in the event that the broader generic claims were held not to be allowable.

Restriction to a Single Sequence Places a Serious Burden on the Applicant

As discussed above, Applicants respectfully submit that the polypeptides, polynucleotides encoding them, cells, compositions, and methods are related, sharing common structural, functional, and useful features despite having different sequences. For example, there are more than a dozen polypeptide species recited in the claims. If the restrictions imposed by the Examiner were proper, Applicant would be required to file no fewer than a dozen patent applications in order to protect these polypeptides, and another dozen in order to protect the polynucleotides encoding these polypeptides. Still more applications would be required to protect the methods of the invention. Applicants respectfully submit that such a large number of applications clearly presents an unreasonable financial burden in obtaining effective patent protection for the invention described in the present application.

Applicants respectfully submit that it is unreasonable to assume that an applicant with limited financial resources would file so many applications. For at least this reason, this type of restriction requirement places some applicants at a disadvantage in protecting their intellectual property. Thus, in the case where an applicant cannot afford the expense of numerous patent applications, the invention is essentially disclosed to the public in its entirety without proper compensation to the applicant in the form of patent protection for the invention.

Restriction to a Single Sequence Differs from Prior USPTO Practice

Applicants respectfully submit that the present requirement to restrict the claims to a single sequence does not follow prior United States Patent and Trademark Office practice, nor is it required. In fact, many more than a single sequence are typically examined. The M.P.E.P. at § 803.04 states that ten sequences is a reasonable number of species. That statement referred directly to polynucleotide sequences, but that it also clearly applies to polypeptide sequences is suggested by the statement that exceptional cases such as "a protein amino acid sequence reciting three dimensional folds [,] may necessitate that the reasonable number of sequences to be selected be less than ten." Even in such exceptional circumstances the MPEP does not say that examination be limited to a singe sequence. Applicants respectfully note that in prosecution of past applications, a much wider range of sequences has been examined, and broad claims have

issued. Thus, Applicants respectfully submit that the present restriction requirement is in contrast to precedent, and thus, in addition to being unduly limiting, is unnecessary.

Such changes in examination practice not only place an undue burden on applicants, as discussed above, but drastically upset the reasonable expectations of the applicants. As the Examiner is no doubt well aware, a patent application represents a significant investment on the part of the applicant. However, where the extent and value of the patent protection that might be obtained is severely restricted, as occurs, for example, when an application directed to a broad invention representing significant work by the applicant is limited to only a single one of the sequences disclosed in the application, the reasonable expectations of an applicant are confounded.

Restriction to a Single Sequence Violates the Quid Pro Quo Underlying U.S. Patent Law

Applicants respectfully submit that the present requirement to restrict the claims to a single sequence would require the disclosure of Applicant's broad invention without providing patent protection commensurate with that disclosure, inequitably violating the delicate balance between an inventor's disclosure of his invention and the protection afforded by U.S. patent law:

> [T]he patent laws require inventors to describe their work in 'full, clear, concise and exact terms,' 35 U.S.C. § 112, as part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations and new ideas beyond the inventor's exclusive rights. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150 (1989).
>
> Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd. 122 S. Ct. 1831, 62 USPQ2d 1705 (2002)

Restriction of Applicants' claims to a single sequence severely limits the breadth of Applicant's right to exclude others from practicing the invention, while providing the world with the full disclosure of the entire breadth of the invention. Applicants respectfully submit that such a severe restriction is inequitable and unfairly takes advantage of the Applicants' disclosure without providing commensurate rights to exclude in compensation.

CONCLUSION

The Examiner is respectfully requested to reconsider the present restriction requirement in view of the arguments provided herein.

By provisionally electing with traverse, providing arguments herein, and requesting the Examiner to reconsider the restriction requirement, Applicants hereby preserve their right to Petition from the requirement for restriction under 37 C.F.R. § 1.144.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641.

Respectfully submitted,

Dated: April 14, 2003

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